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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
VIKRAM RAI

Serial No.: 09/849,088

Filed: MAY 4, 2001

For: INFORMATION DELIVERY METHOD
FOR COMMUNICATION SYSTEMS

Examiner: T. Davis

Group Art Unit: 2681

Att'y Docket: 2100.013300

Customer No. 046290

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING 37 C.F.R. 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:	
<u>10-28-05</u> Date	<u>Kathy Alana</u> Signature

Sir:

Appellant hereby submits this Appeal Brief to the Board of Patent Appeals and Interferences in response to the decision of the Examiner dated September 7, 2005. A Notice of Appeal was filed on September 13, 2005 and so this Appeal Brief is believed to be timely filed.

A check in the amount of \$500.00 as cost for filing this Appeal Brief is attached. However, should the check be inadvertently omitted the Commissioner is authorized to deduct Williams, Morgan & Amerson's P.C. Deposit Account 50-0786/2100.013300.

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I. REAL PARTY IN INTEREST

The present application is owned by Lucent Technologies, Inc. The assignment of the present application to Lucent Technologies, Inc., is recorded at Reel 11789, Frame 0491.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF THE CLAIMS

Claims 1-14 are pending in the application. Claims 1, 7-9, and 11-14 stand rejected under 35 U.S.C. 102(e) as being anticipated by Sumner (U.S. Patent No. 6,091,947). Claims 2-3, 5-6, and 10 stand rejected under 35 U.S.C. 103(a) as being obvious over Sumner in view of Boltz, et al (U.S. Patent No. 6,044,275). Claim 4 stands rejected under 35 U.S.C. 103(a) as being obvious over Sumner in view of Boltz and further in view of Matsukane, et al (U.S. Patent No. 5,467,341).

IV. STATUS OF AMENDMENTS

There were no amendments after the final rejections.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 sets forth a method for delivering user information over a communication system. The method may include receiving user identified storable information comprising voice signals over a signaling channel and transmitting the received information to a

destination over an available traffic channel. User identified storable information is information carried by a user signal that has been identified by the user as information that, once received by the system over a signaling channel, is to be transmitted (not in real time) by the system over an available traffic channel to its destination at a user (or system) specified time. See Patent Application, page 5, ll. 22-26. For example, an end user 1 may operate a cell phone 202 such that information to be transmitted is labeled as user identified storable information. The end-user 1 may then operate a cell phone 2002 to send a voice message including the user identified storable information from the cellular phone 202 to base station 206 over a signaling channel of an air interface 204 that includes both signaling channels and traffic channels. The base station 206 may store and later transmit the user identified storable information to cellular telephone 210 over a traffic channel. See Patent Application, page 7, line 5 - page 8, line 2 and Figure 2.

Independent claim 9 sets forth a method for transmitting user identified storable information with a communication device over a communication system. The method may include formatting user identified storable information comprising voice signals in accordance with a protocol being followed by the communication system and transmitting the user identified storable information comprising voice signals over at least one signaling channel of the communication system. For example, the cellular telephone 202 may be configured such that it formats and labels the user identified storable information. The end-user 1 may then operate the cell phone 2002 to send a voice message including the formatted user identified storable information from the cellular phone 202 to base station 206 over a signaling channel of an air interface 204. See Patent Application, page 7, line 5 - page 8, line 2 and Figure 2.

Independent claim 12 sets forth a method for receiving user identified storable information with a communication device over a communication system. The method may

include receiving an alert signal over a signaling channel of the communication system, transmitting a response signal over a signaling channel of the communication system, and receiving user identified storable information comprising voice signals over a traffic channel of the communication system. For example, the base station 206 may transmit an alert signal over a signaling channel of air interface 208 to the cellular phone 210, which may send a response signal over a signaling channel of air interface 208 to base station 206. The base station 206 may then transmit user identified storable information to cellular telephone 210 over a traffic channel. See Patent Application, page 9, ll. 1-22 and Figure 1.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the Board review and overturn the three rejections present in this case. The following issues are presented on appeal in this case:

- (A) Whether claims 1, 7-9, and 11-14 are anticipated by Sumner;
- (B) Whether claims 2-3, 5-6, and 10 are obvious over Sumner in view of Boltz; and
- (C) Whether claim 4 is obvious over Sumner in view of Boltz and further in view of Matsukane.

VII. ARGUMENT

A. Legal Standards

An anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Moreover, it is the claimed invention, as a whole, that must be considered for purposes of determining obviousness. A mere selection of various bits and pieces of the claimed invention from various sources of prior art

does not render a claimed invention obvious, unless there is a suggestion or motivation in the prior art for the claimed invention, when considered as a whole.

It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. See, *inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

B. Claims 1, 7-9, and 11-14 are not anticipated by Sumner.

Sumner describes a technique for determining (at step 406) transmission and reception rates associated with a handset and the base unit. If the transmission and/or reception rates cannot accommodate a normal voice connection, then the call is routed to a voicemail deposit process (step 408). See Sumner, col. 7, ll. 6-63 and Figure 4. The stored voicemail message may later be delivered to the handset (at 508). See Sumner, col. 8, ll. 14-54 and Figure 5.

However, Sumner is completely silent with regard to user identified storable information. As discussed above, user identified storable information is information carried by a user signal that has been identified by the user as information that, once received by the system over a signaling channel, is to be transmitted (not in real time) by the system over an available traffic channel to its destination at a user (or system) specified time. In contrast, Sumner teaches that the communication system decides whether or not a call should be routed to a voicemail deposit process (step 408) based on the transmission and/or reception rates. Thus, Sumner fails to teach or suggest user identified storable information.

For at least the aforementioned reasons, Appellants respectfully submit that the present invention is not anticipated by Sumner and request that the Examiner's rejections of claims 1, 7-9, and 11-14 under 35 U.S.C. 102(e) be REVERSED.

C. Claims 2-3, 5-6, and 10 are not obvious over Sumner in view of Boltz.

As discussed above, Sumner is completely silent with regard to user identified storable information. Boltz describes techniques for time-defined delivery of messages. However, Boltz is also completely silent with regard to user identified storable information.

Furthermore, the cited references provide no suggestion or motivation to modify the prior art to arrive at the claimed invention. To the contrary, Sumner teaches away from receiving, storing, or transmitting user identified storable information. In particular, Sumner teaches that the communication system decides whether or not a call should be routed to a voicemail deposit process (step 408) based on the transmission and/or reception rates. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.

For at least the aforementioned reasons, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that the present invention is obvious over the prior art of record and requests that the Examiner's rejections of claims 2-3, 5-6, and 10 under 35 U.S.C. 103(a) be REVERSED.

D. Claim 4 is not obvious over Sumner in view of Boltz and further in view of Matsukane.

As discussed above, Sumner and Boltz are completely silent with regard to user identified storable information. Matsukane describes techniques for alerting users. However, Matsukane is also completely silent with regard to user identified storable information.

Furthermore, the cited references provide no suggestion or motivation to modify the prior art to arrive at the claimed invention. To the contrary, Sumner teaches away from receiving, storing, or transmitting user identified storable information. In particular, Sumner teaches that the communication system decides whether or not a call should be routed to a voicemail deposit process (step 408) based on the transmission and/or reception rates. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.

For at least the aforementioned reasons, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that the present invention is obvious over the prior art of record and requests that the Examiner's rejections of claim 4 under 35 U.S.C. 103(a) be REVERSED.

VIII. CLAIMS APPENDIX

The claims that are the subject of the present appeal – claims 1-14 – are set forth in the attached “Claims Appendix.”

IX. EVIDENCE APPENDIX

There is no separate Evidence Appendix for this appeal.

X. RELATED PROCEEDINGS APPENDIX

There is no Related Proceedings Appendix for this appeal.


XI. CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application, claims 1-14, over the prior art of record. The undersigned may be contacted at (713) 934-4052 with respect to any questions, comments or suggestions relating to this appeal.

Respectfully submitted,

Date: _____

10/28/05



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AGENT FOR APPELLANTS



CLAIMS APPENDIX

1. (PREVIOUSLY PRESENTED) A method for delivering user information over a communication system, the method comprising the steps of:

receiving user identified storable information comprising voice signals over a signaling channel; and

transmitting the received information to a destination over an available traffic channel.
2. (ORIGINAL) The method of claim 1 where the step of receiving user identified storable information further comprises the steps of:

storing the received information;

determining a transmission time and a destination from the received information;

transmitting an alert signal over a signaling channel to the destination; and

receiving a response signal over the signaling channel from the destination.
3. (ORIGINAL) The method of claim 2 where the step of transmitting an alert signal comprises:

formatting the alert signal in accordance with a protocol being followed by the communication system; and

transmitting the alert signal over a signaling communication channel prior to the transmission time where the transmission time is specified by the user or by the system.
4. (ORIGINAL) The method of claim 2 where the alert signal is transmitted a certain number of times designated by the user.

5. (ORIGINAL) The method of claim 2 where the step of transmitting an alert signal further comprises the steps of:

waiting for a user specified time period for a signal responding to the transmitted alert signal;

retransmitting the alert signal a certain number of times specified by the user; and

transmitting a message to the user over a signaling channel informing the user that the information cannot be delivered to its destination when no response signal is received after a certain number of retransmission has occurred.

6. (ORIGINAL) The method of claim 2 where the step of determining a transmission and a destination address comprises the step of retrieving transmission time data and the destination data from the received information.

7. (ORIGINAL) The method of claim 1 where the received information is transmitted over an available traffic channel at a time determined by the communication system when the user has not specified a transmission time.

8. (ORIGINAL) The method of claim 1 further comprising the step of postponing the transmission of the received information until at least one traffic channel becomes available.

9. (PREVIOUSLY PRESENTED) A method for transmitting user identified storable information with a communication device over a communication system, the method comprises the steps of:

formatting user identified storable information comprising voice signals in accordance with a protocol being followed by the communication system; and

transmitting the user identified storable information comprising voice signals over at least one signaling channel of the communication system.

10. (ORIGINAL) The method of claim 9 where the step of formatting user identified storable information comprises the steps of:

obtaining the user identified storable information with a communication device; and

inserting transmission time data and the destination data in the user identified storable information.

11. (ORIGINAL) The method of claim 9 where the communication device is either a cellular phone, a PDA or a personal computer.

12. (PREVIOUSLY PRESENTED) A method for receiving user identified storable information with a communication device over a communication system, the method comprising the steps of:

receiving an alert signal over a signaling channel of the communication system;

transmitting a response signal over a signaling channel of the communication system; and

receiving user identified storable information comprising voice signals over a traffic channel of the communication system.

13. (ORIGINAL) The method of claim 12 where the step of transmitting a response signal over a signaling channel comprises formatting the response signal in accordance with a protocol being followed by the communication system.

14. (ORIGINAL) The method of claim 9 where the communication device is either a cellular phone, a PDA or a personal computer.